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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,951	03/22/2001	Jean Pierre Menard	0011-048	6933
40972	7590	08/09/2004	EXAMINER	
HENNEMAN & SAUNDERS 714 WEST MICHIGAN AVENUE THREE RIVERS, MI 49093			DONOVAN, LINCOLN D.	
			ART UNIT	PAPER NUMBER
			2832	

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2078

<b>Office Action Summary</b>	<b>Application No.</b> 09/816,951	<b>Applicant(s)</b> MENARD, JEAN PIERRE	
	<b>Examiner</b> Lincoln Donovan	<b>Art Unit</b> 2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-25 is/are allowed.
- 6) ☒ Claim(s) 1 and 26 is/are rejected.
- 7) ☒ Claim(s) 2-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claim 27 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 27 is directed to an embodiment not previously presented or considered.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 27 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spring [US 6,480,347].

Spring discloses a holding apparatus comprising:

- a support [10] having a grip face [figure 1] including a plurality of magnet means [30A-30D] adapted to abut an prism carrier/optical device [22]; and
- magnet means [28A-28D] mounted on the optical device to selectively magnetically engage the support.

Spring discloses the instant claimed invention except for the optical device being an imager.

It would have been obvious to one having ordinary skill in the art at the time the invention was made that the support design of Spring could have been used to support an optical imager in order to facilitate positioning and interchangeability thereof.

Claim 26 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Spring as applied to claim 1 above, and further in view of Stagnitto et al. [US 5,993,365].

Spring disclose the instant claimed invention except for the selectivity of the magnetically engagement being controlled by movement of the magnet relative to a shunt path.

Stagnitto et al. discloses a tool attachment/detachment means using a permanent magnet [42] interacting with shunt blocks [16] to direct the magnetic flux and hold or release the tool attachment. [claim 3, column 7 line 60-column 8 line 8] to pole support pieces [38].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the permanent magnet/shunt attachment/detachment means in Spring, as suggested by Stagnitto et al., for the purpose of facilitating the interchangeable/selective mounting of the optical device.

The particular shape of the permanent magnet and shunt pieces and arrangement of the pole pieces would have been an obvious design consideration based on the specific configuration of the workpiece to be held.

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Stagnitto et al. discloses the attachment securing the magnet in place [figures 4-5].

The specific method steps claimed would have been necessitated by the claimed product structure.

***Allowable Subject Matter***

Claims 12-25 are allowed.

Claims 2-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 09-02-03 have been fully considered but they are not persuasive.

Applicant argues:

[1] Spring fails to disclose the "selective movement" of the optical member;

[2] A skilled artisan would not have been motivated to use the optical element mounting design of Spring with an imager structure; and

[3] Spring does not specifically claim an imager and is non-analogous art.

Examiner disagrees:

Regarding [1]: Spring discloses selective movement of the optical device [column 2, lines 46-65].

Regarding [2]: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be

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established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a skilled artisan would have been inclined to seek means to selectively mount an optical device or an imager in order to provide various control and positioning thereof.

Regarding [3]: In response to applicant's argument that Stagnitto et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a skilled artisan desiring to control the mounting of an optical device would desire to look at alternative magnetic device mounting designs.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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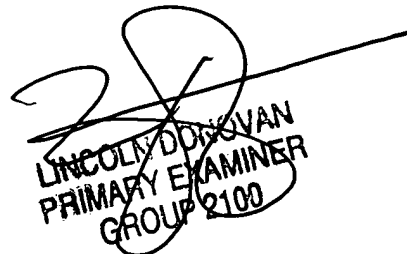
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lincoln Donovan whose telephone number is (571) 272-1988. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ldd

  
LINCOLN DONOVAN  
PRIMARY EXAMINER  
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